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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056168
Party	Plaintiff Legend Pictures LLC
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Attachments	Petitioner's Motion to Amend and Certificate of Service.pdf(5764458 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

LEGEND PICTURES, LLC,)	
)	
Petitioner)	
)	
v.)	Cancellation No. 92056168
)	
QUENTIN DAVIS,)	
)	
Defendant)	

PETITIONER'S MOTION FOR LEAVE TO AMEND THE PETITION TO CANCEL

Pursuant to Trademark Rule 2.107 (37 CFR. § 2.107) and Rule 15(a) of the Federal Rules of Civil Procedure, Petitioner Legend Pictures, LLC ("Petitioner") moves the Board for Leave to Amend its Petition to Cancel to plead that: (1) Registration No. 3,412,677 has become incontestable; 2) Petitioner's Registrations, Nos. 3,656,926 and 3,621,043 have been amended; and 3) Petitioner has used the terms LEGENDARY and LEGENDARY PICTURES as and as part of its trade names.

The proposed Amended Notice of Cancellation is attached hereto.

**I. BACKGROUND: MOTIONS FOR LEAVE TO AMEND SHALL BE GRANTED
FREELY**

Federal Rule 15(a) states as follows: "[A] party may amend the party's pleading.. .by leave of court ...; and leave shall be freely given when justice so requires." See TBMP § 507.02.

In interpreting this provision, the Board has been liberal in granting leave to amend pleadings at any stage of the proceedings, but especially pretrial, when justice so requires, provided the proposed amendment would not violate settled law or be prejudicial to the rights of the adverse party. See e.g., *Commodore Electronics Ltd. v. CMB Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (motion to amend granted and no prejudice where non-moving party already had taken discovery on the newly plead issues). See e.g. *United States Olympic Committee v. O-M Bread, Inc.*, 26 USPQ2d 1221 (TTAB 1993) (motion granted where proceeding was still in pre-trial stage); *Focus 21 International, Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992) (motion granted where motion was filed prior to the opening of plaintiffs testimony period); and *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (motion granted where in the interest of justice).

Here, the motion is filed pre-trial. And justice would be served by permitting all the parties claims to be considered in one case. Further, Defendant will not be unduly prejudiced by this motion.

As all the conditions of Rule 15 are met, this Motion should be granted.

A) AT THE TIME OF FILING THE PETITION TO CANCEL, PETITIONER'S REGISTRATION NO. 3,412,677 HAD NOT YET BECOME INCONTESTABLE AND REGISTRATION NOS. 3,656,926 AND 3,621,043 HAD NOT YET BEEN AMENDED BY THE USPTO AND THE REMAINING ALLEGATIONS CONFORM THE PETITION TO DISCOVERY

1. Registration No. 3,412,677

On September 13, 2012, Petitioner filed a Petition to Cancel, containing three claims. One of these claims is for likelihood of confusion. At the time the Petition to Cancel was filed, Registration No. 3,412,677 was not incontestable. Thus, Petitioner plead this mark as a valid and subsisting registration only.

On April 23, 2013, Petitioner filed a Section 8 and 15 Declaration as to Registration No. 3,412,677. On May 15, 2013, this registration became incontestable.

Promptly after the registration became incontestable, Petitioner is moving to amend the Cancellation. This motion is being filed within two weeks of the USPTO's decision accepting the Declarations of Use and Incontestability and therefore is timely.

2. Registration Nos. 3,656,926 and 3,621,043

Justice also requires that the Board grant leave to amend the Cancellation to plead Petitioner's Amendment of its pleaded Registrations identified above. On August 29, 2012, Petitioner filed Section 7(e) Requests to Amend these registrations from LEGENDARY PICTURES & Design to LEGENDARY & Design. On September 13, 2012, Petitioner filed the Petition to Cancel. As the Section 7(e) Requests to Amend had not yet been approved, Petitioner and ESSTA both properly identified the marks in these registrations as LEGENDARY PICTURES & Design.

On October 22, 2013, Defendant Answered the Petition for Cancellation. Defendant knew of the pending Section 7(e) Requests to Amend when Defendant filed his Answer. Specifically, Defendant, in his Answer to paragraph Nos. 3 and 5 of the Petition to Cancel pled as follows:

3. Petitioner, ... voluntarily requested Registration No. 3656926 for amendment on Aug. 29, 2012. The amended drawing removed the word "PICTURES" from Registration No. 3656926 and left only the word "LEGENDARY" (including medallion) remaining.

5. Petitioner, ... voluntarily requested Registration No. 3621043 for amendment on Aug. 29, 2012. The amended drawing removed the word "PICTURES" from Registration No. 3656926 (sic) and left only the word "LEGENDARY" (including medallion) remaining.

Further, on May 28, 2013,¹ Petitioner timely and without extension responded to Defendant's First Set of Interrogatories and Requests for Production of Documents, which had been served on April 27, 2013.

Defendant's Interrogatory No. 10 and Request for Production No.10 sought a description of the reason for Petitioner's Voluntary Amendments. See, Exhibit A. Petitioner answered these discovery requests. *Id.* Thus, for seven months, Defendant has known of the Amendments of Petitioner's Registrations. Further, Defendant has taken discovery on this issue.

Nonetheless, to clarify the case, to avoid any claim of "surprise" at trial, and to avoid any possible arguments regarding prejudice to Defendant, Petitioner seeks to amend the Cancellation. Petitioner seeks to expressly plead the Amendments to Petitioner's Registrations.

As indicated above, precedent mandates that leave to amend pleadings should be freely granted, when justice so requires, provided the proposed amendment would not violate settled law or be prejudicial to the rights of the adverse party. *Supra*, at p.2.

¹ May 27, 2013 was a federal holiday.

As it will conform the pleadings to the evidence and permit the Board to hear all facts pertinent to likelihood of confusion, justice clearly will be served by permitting the amendments. As he has been aware of these Amendments since at least as early as October 22, 2013, and has taken discovery on the Amendments, Defendant cannot be prejudiced by allowance of this amendment.

The Board regularly grants leave to amend to plead a registration issued to the Plaintiff after the original complaint's filing. *VanDyne Cotty Inc. v. Wear-guard Corp*, 926 F2d 1156, 17 USPQ2d 1866, 1867 (Fed Cir 1991); *Cudahy Co v August Packing Co*. 206 USPQ 759 (TTAB 1979) [Petitioner permitted to plead ownership of registrations acquired after the filing of the Notice of Opposition]. Petitioner respectfully submits that this case is similar to these cases in that Petitioner is simply updating the status of its pled marks, and requests that the Board act consistently with these precedents.

B) PETITIONER'S USE OF THE TERM "LEGENDARY" AS AND AS PART OF ITS TRADE NAMES

Justice also requires that the Board grant leave to amend the Cancellation to amplify allegations already included in Petitioner's pleading of the use of the term LEGENDARY and LEGENDARY PICTURES as or as part of a trade name. On September 13, 2012, Petitioner filed its Petition to Cancel. The Petition's Paragraph 9 read as follows:

9. The entirety of Registrant's mark LEGENDARY is incorporated within Petitioner's LEGENDARY PICTURES marks. Consequently, Registrant's mark LEGENDARY would appear to consumers to be a shortened form of Petitioner's LEGENDARY PICTURES marks. *In fact, media reports have commonly referred to Petitioner using the shortened mark LEGENDARY.* Consumers are

therefore likely to mistakenly believe that Registrant's mark is associated or affiliated with Petitioner's mark.

On October 22, 2013, Defendant answered the Petition to Cancel. Defendant plead as follows:

9....Registrant also denies claims that media reports *commonly* refer to Petitioner using the shortened mark "LEGENDARY", as extensive searches have been made to locate evidence in support of this claim. No evidence to validate this claim has been found. Findings in media outlets have referred to Petitioner as: "LEGENDARY PICTURES" or "LEGENDARY ENTERTAINMENT" or "LEGENDARY FILMS" or "LEGENDARY COMICS" or "LEGEND PICTURES". *No evidence could be found of the Petitioner even to refer to itself as LEGENDARY without the inclusion of its identifying medallion.*

Thus, since at least as early as October 22, 2013, the parties have joined issue on the degree to which Petitioner uses and is known by the term "LEGENDARY"

For over six months, Defendant has known of this basis for Petitioner's claim of likelihood of confusion. Where, as here, a party seeks leave to amend the Cancellation to amplify its allegations so that the Board may decide a case based on "the fullest exposure of all pertinent circumstances," the Board has consistently granted such amendments. See, *Avedis Zildjian Co. v. D.H. Baldwin Co.* 180 USPQ 539 (TTAB 1973).

Further, Defendant already has extensively taken discovery on this issue. On May 28, 2013, Petitioner responded to Defendant's First Set of Interrogatories and Requests for Production of Documents.

Well over **half** of Defendant's discovery requests, as numbered by Defendant, were directed to Petitioner's use of the terms LEGENDARY and LEGENDARY PICTURES as a trade name. Specifically, Interrogatory Nos. 1, 2, 3, 4 and 5 sought a description of when Petitioner first began advertising itself as LEGENDARY or LEGENDARY PICTURES. Exhibit A. Interrogatory Nos. 6 and 7 sought a description of all "media outlets" and all documents from such "media outlets" in which Petitioner refers to itself as LEGENDARY or LEGENDARY PICTURES. *Id.* Similarly, Request for Production Nos. 1-5 seek documents reflecting Petitioner's first use of LEGENDARY or LEGENDARY PICTURES as a trade name. *Id.* Request for Production Nos. 6-7 seek documents reflecting all "media outlets" use of LEGENDARY and LEGENDARY PICTURES to refer to Petitioner. *Id.*

These discovery requests and Petitioner's answers to these discovery requests confirm that Defendant understood that Petitioner alleges to have used the terms LEGENDARY and LEGENDARY PICTURES as or as part of its trade names. These uses were adequately plead and issues joined thereon in this case. *Id.*

Nonetheless, simply to amplify the Cancellation, to avoid any claim of "surprise" at trial, and to avoid any possible prejudice to Defendant, Petitioner seeks to amend the Cancellation. Petitioner seeks to amplify its pleading of its use of LEGENDARY and LEGENDARY PICTURES as and as part of its trade names as a basis for its claim of likelihood of confusion as set forth in the Original Petition for Cancellation and joined in Defendant's Answer.

As indicated above, precedent mandates that leave to amend pleadings should be freely granted, when justice so requires, provided the proposed amendment would not violate settled law or be prejudicial to the rights of the adverse party. See e.g., See, *Avedis Zildjian Co. v. D.H. Baldwin Co.* 180 USPQ 539 (TTAB 1973).

As it will permit the Board to hear all facts pertinent to likelihood of confusion, justice clearly will be served by permitting the amendment. And as he has been aware of these issues by Petitioner since he filed his Answer, and has taken discovery on these issues, Defendant cannot be prejudiced by allowance of this amendment.

D. CONCLUSION

Thus, for the foregoing reasons, Petitioner's Motion for Leave to Amend the Petition to Cancel should be granted since doing so does not violate any settled law, since the request is timely, since it will not prejudice the rights of the Defendant, and since justice so requires.

Respectfully submitted,

Legend Pictures, LLC

Date May 30, 2013

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 30, 2013 a true and accurate copy of the foregoing:

**PETITIONER'S MOTION FOR LEAVE TO AMEND THE PETITION TO CANCEL,
EXHIBIT A, AND AMENDED PETITION TO CANCEL**

was served by agreement of the parties on Defendant by emailing a copy of the same to nevisbaby@hotmail.com and tharilest@yahoo.com.

/Carla Calcagno/